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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 601.

RANDOLPH LABORATORIES, INC., *Petitioner*

v.

SPECIALTIES DEVELOPMENT CORPORATION, *Respondent.*

REPLY BRIEF FOR PETITIONER

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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Respondent in its brief makes no answer to petitioner's charge that its conduct before the Patent Office in prosecuting its application upon which the reissue patent here in suit was granted constituted a fraud on the Patent Office. Instead respondent asserts that the question of fraud in obtaining the patent is to be determined *solely* by the validity of the claim obtained, and the Court of Appeals, having affirmed its finding of validity (by reading into the claim the specific anti-recoil device disclosed in the patent specification) the question of *how* the claim was obtained becomes moot.

Whether or not the respondent's conduct in obtaining its reissue in 1933 was fraudulent cannot be determined

by the construction placed upon the patent in 1949. It takes no expert to see that claim 16 of the reissue patent as obtained in 1933, without the limitation read into it in 1949, applies as well on the prior Fyre-Freez* structure as it does on the device illustrated in the reissue patent drawings. By *not* disclosing to the Patent Office the fact that the Fyre-Freez structure had been in public use and on sale more than two years prior to the filing of the application of the reissued patent, respondent obtained in its reissue patent a broad claim covering *all forms* of anti-recoil device when positioned in the discharge outlet of the extinguisher. The judgment of the Court of Appeals that the patent may be construed as valid by reading into it the specific form of anti-recoil device disclosed in the specifications of the reissued patent makes it no less a fraud to obtain a broad claim *not so limited* by concealing from the Patent Office the prior public use and sale of the Fyre-Freez structure.

The decision of the Court of Appeals as expressed in the opinion denying our petition for leave to present this issue of fraud to the District Court (R. 26-32) will encourage applicants for broadened reissues to ask for claims which they know they are not entitled to and to make the required oath that the invention defined in such claims "was not known or used before their invention or discovery thereof", with the mental reservation that the broad claim which they are asking for may, if the *concealed* prior device does come to light in some subsequent litigation, be construed as valid by reading into it the limitations *purposely omitted* in the drafting of the claim.

The practice thus tacitly approved in the opinion of the Court of Appeals for the Third Circuit will result in a grave abuse of the privileges provided by the reissue statutes and is totally inconsistent with the rulings of this Court in *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U.S. 238

* The Fyre-Freez structure is illustrated in the drawing at page 47 of the record, and claim 16 appears at page 46.

(1944), and *Precision Co.* v. *Automotive Co.*, 324 U.S. 806 (1945), requiring the utmost frankness and honesty on the part of applicants for patents in their dealings with the Patent Office. In these cases this Court was not concerned with the validity of the patent obtained by concealing the true facts from the Patent Office but held that whenever pertinent facts were concealed or misrepresented in the prosecution of patent applications the patents obtained should not be enforced.

Respondent asserts (p. 3, Respondent's brief) that the Fyre-Freez structure was before the Patent Office. So it was—in a co-pending application which was not only *not* prior to the original application of the reissued patent, but was in fact filed more than two years subsequent to the public use and sale of the Fyre-Freez device. As stated in the affidavit of Mr. Porter, former Examiner-in-Chief of the Patent Office (R. 41, 42), the disclosure of a device in an application so presented constitutes "an affirmative declaration" that such device is *not* prior to the subject-matter claimed in the co-pending application.

Respectfully submitted,

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